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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209617
Party	Defendant Debra Wiseberg
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Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Debra Wiseberg
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Signature	/Debra Wiseberg/
Date	08/14/2014
Attachments	Applicant'sAmendedCounterclaim.pdf(1310534 bytes)

“cigar” sales.

4. The Opposer has tried to have consumers pronounce their mark “Xikar” as “cigar”.

5. The “Xikar” trademark is generic because the registration is for “cigar cutters” and the translation and meaning of “xikar” is “cigar”; the genus of the Opposer’s goods are cigar accessories and cigars.

6. The “Xikar” trademark is for ‘cigar cutters’ which are made for and to be used with “cigars” making the “Xikar” trademark functional.

7. The Mayans are the first people known to cultivate and smoke cigars and are the reason the cigar industry exists.

8. The Opposer has deceptively made statements of a strong affiliation with the Mayans and has named various products after the Mayans.

9. Consumers may mistakenly believe the Opposer and its goods derive and originate from the Mayans and believe there is an increased quality and history to such goods.

10. “Xikar” has been used by the Opposer as a “trade name” and “corporation name” since before the Application to register the trademark “Xikar” for “cigar cutters” was filed. The Trademark Act does not provide for registration of trade names. The Opposer uses various product names to identify their goods.

11. “Xikar” has been and continues to be used solely as a trade name and corporation name for the Opposer.

12. Xikar, Inc., a Kansas for Profit Corporation was formed on February 5, 1996 to engage in “wholesale and retail cigar cutter sales”.

13. Xikar, Inc., a Kansas corporation is considered a separate legal entity from all shareholders, officers, and directors associated with said corporation.

14. Kurt Van Keppel, an individual did not have a bona fide intention to use the mark

in commerce when he filed the application for US Registration No. 2200215 on August 19, 1996.

15. Kurt Van Keppel, an individual did not use the mark "Xikar" in interstate commerce between the dates of February 6, 1997 and March 25, 2004 as stated and required.

16. The Application to register the trademark "Xikar" filed on August 19, 1996; the Statement of Use filed on December 8, 1997; and the Declaration under 37 C.F.R. § 2.20 filed on August 3, 1998 did not state that the mark was being used in commerce by other than Kurt Van Keppel, an individual and should be disregarded and deemed invalid and void.

17. Kurt Van Keppel transferred ownership of the trademark "Xikar" to the Opposer by Assignment filed on April 6, 2004 immediately before the Declaration of Use and Incontestability under Sections 8 & 15 was filed by Xikar, Inc. (omitting the state of incorporation) on April 15, 2004 stating the mark was being used in commerce by Xikar, Inc.

18. The Assignment between Kurt Van Keppel, an individual, as Assignor and Xikar, Inc., a Kansas corporation, as Assignee stated that the goodwill of the business associated therewith was transferred between the parties, when Kurt Van Keppel, an individual, did not have a business to transfer, when the goods associated with said mark were sold by and through Xikar, Inc., a Kansas corporation, since inception and not by Kurt Van Keppel, an individual.

19. The Assignment and transfer of the federal registration for the "Xikar" trademark between Kurt Van Keppel, an individual, as Assignor and Xikar, Inc., a Kansas corporation, as Assignee, should be disregarded and deemed invalid and void due to the fact that Kurt Van Keppel did not have an ongoing and existing business to transfer regarding the said mark and neither an amendment nor a verified statement of use was filed by Xikar, Inc., a Kansas corporation.

20. The trademark for "Xikar" should not be considered incontestable because the Declaration of Use and Incontestability under Sections 8 & 15 was filed on April 15, 2004 by Xikar, Inc. a Kansas corporation because the Application; Statement of Use; Declaration; and

Assignment filed in connection with the federal trademark "Xikar" should be disregarded and deemed invalid and void.

21. The Declaration of Use and Incontestability under Sections 8 & 15 filed on April 15, 2004 by Xikar, Inc., a Kansas corporation, should be disregarded and deemed invalid and void.

22. The Opposer has fraudulently and improperly used the registration symbol by affixing the "Xikar®" trademark on goods and slogans as a trade name and commercial name for which the federal registration for the trademark "Xikar" does not apply.

23. The trademark "Xikar" contains non-English wording and such was not disclosed on the application to register said mark. Kurt Van Keppel and the Opposer were not only aware of the non-English translation, the mark was procured from such knowledge.

24. Kurt Van Keppel and the Opposer have fraudulently tried to obtain rights to the words "cigar"; "sikar"; and "zikar".

COUNTERCLAIMS FOR CANCELATION

I. GENERIC AND II. FUNCTIONAL - TRADEMARK ACT §14(3);

15 U.S.C. § 1064(3)

25. The Applicant reiterates and re-alleges, as if fully set forth herein, the allegations contained in the foregoing paragraphs 1 through 8, and 22 through 24, which are hereby incorporated into paragraphs 25 and 26.

26. Pursuant to Trademark Act §14(3); 15 U.S.C. § 1064(3); and based on the allegations contained herein, US Registration No. 2200215 for the trademark "Xikar" for "cigar cutters" should be canceled due to the fact that "xikar" is a translation of the word "cigar" and therefore the Opposer's mark "Xikar" is generic and functional in nature; the Opposer has tried to have consumers pronounce their mark "Xikar" as "cigar"; and the Opposer has used the

"Xikar®" mark in the sale and promotion of "cigars".

III. CONSISTS OF AND COMPRISES DECEPTIVE MATTER - TRADEMARK ACT § 14(3); 15 U.S.C. § 1064(3); TRADEMARK ACT § 2(a); 15 U.S.C. §1052(a)

27. The Applicant reiterates and re-alleges, as if fully set forth herein, the allegations contained in the foregoing paragraphs 1 through 9, which are hereby incorporated into paragraphs 27 through 29.

28. Pursuant to Trademark Act §14(3); 15 U.S.C. § 1064(3); Trademark Act § 2(a); 15 U.S.C. §1052(a); and based on the allegations contained herein, US Registration No. 2200215 for the mark "Xikar" should be canceled due to the fact that it consists of and comprises deceptive matter.

29. The Opposer's use of the Mayan word "Xikar"; the Mayans long known history with cigars; the Opposer's statements of an affiliation with the Mayans; and the Opposer naming products after the Mayans may deceive consumers into believing the Opposer and its goods derive or originate from the Mayans and therefore induce consumers to purchase the Opposer's goods with the belief that there is an increased quality and history to such goods.

IV. MISREPRESENTATION AS TO SOURCE OF GOODS – TRADEMARK ACT §14(3); 15 U.S.C. § 1064(3)

30. The Applicant reiterates and re-alleges, as if fully set forth herein, the allegations contained in the foregoing paragraphs 1 through 9 and 29, which are hereby incorporated into paragraphs 30 and 31.

31. Pursuant to Trademark Act §14(3); 15 U.S.C. §1064(3); and based on the allegations contained herein, US Registration No. 2200215 for the mark "Xikar" should be canceled due to the fact that the actions and statements made by the Opposer may cause confusion in consumers as to the source of the Opposer's goods.

V. FRAUD - TRADEMARK ACT §14(3); 15 U.S.C. § 1064(3)

32. The Applicant reiterates and re-alleges, as if fully set forth herein, the

allegations contained in the foregoing paragraphs 1 through 24, which are hereby incorporated into paragraphs 32 through 39.

33. Pursuant to Trademark Act §14(3); 15 U.S.C. § 1064(3); and based on the allegations contained herein, US Registration No. 2200215 for the mark “Xikar” should be canceled because it was fraudulently obtained and has been fraudulently used by Kurt Van Keppel and the Opposer.

34. Kurt Van Keppel and the Opposer did knowingly and fraudulently procure the registration of the mark “Xikar” for “cigar cutters” to avoid the inability to register a “trade name” and “corporation name”.

35. Kurt Van Keppel and the Opposer knew the mark “Xikar” was not being used by Kurt Van Keppel, an individual, in interstate commerce between the dates of February 6, 1997 and April 6, 2004 and did knowingly and fraudulently keep such information from the USPTO.

36. Kurt Van Keppel and the Opposer did knowingly and fraudulently obtain US Registration No. 2200215 for the mark “Xikar” based on an invalid 1) Application; 2) Statement of Use; 3) Declaration; 4) Assignment; 5) and Declaration of Use and Incontestability under Sections 8 & 15.

37. The Opposer did knowingly and fraudulently mis-use the federal registration symbol for the mark “Xikar®” on goods and slogans as a trade name and commercial name for which US Registration No. 2200215 does not apply and deceiving the public as to the rights the Opposer can claim in such federal trademark both before and after such trademark was granted.

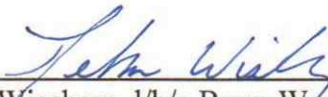
38. Kurt Van Keppel and the Opposer did knowingly and fraudulently not disclose the non-English translation of the mark “Xikar” to the USPTO.

39. Kurt Van Keppel and the Opposer have knowingly and fraudulently tried to obtain rights to the words “cigar”; “sikar”; and “zikar”, and their characteristics through the registration of the trademark “Xikar”.

WHEREFORE, the Applicant is damaged by the federal trademark registration for the mark "Xikar" and prays that the Board will grant her amended counterclaim against the Opposer and cancel US Registration No. 2200215 for the trademark "Xikar".

Dated: August 14, 2014

Respectfully submitted,

By: 
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CERTIFICATE OF FILING

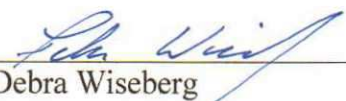
I hereby certify that the Applicant's Amended Counterclaim was filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on August 14, 2014.

By: 
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant's Amended Counterclaim was sent to the counsel for the Opposer by the United States Postal Service, first class mail on August 14, 2014 to the following address:

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By: 
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